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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,619	02/09/2001	Tom L. Young	10522/38	6551

7590 06/04/2003

Brinks Hofer Gilson & Lione  
PO Box 10395  
Chicago, IL 60610

EXAMINER

LITHGOW, THOMAS M

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/762,619

Applicant(s)

YOUNG ET AL.

Examiner

Thomas M. Lithgow

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 19-23 and 25-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-18, 24 and 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: *John M. Long*

### **DETAILED ACTION**

1. Applicant's election with traverse of "natural oils" and the process claims 1-24 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there was no holding of lack of unity in the international phase of the examination- PCT and the examiner should abide by such findings. The statute 35USC 372(b) which grants explicit authority for the Commissioner to revisit lack of unity issues during the national phase of a PCT filed application. The statute however only relates to international applications designating the US but not originating in the US. The instant case originates in the US and the statute is silent as to this situation. The Examiner holds that such language of the above statute and 37CFR 1.499, and 37 CFR1.475 do not prohibit the examiner to revisit the question of a proper lack of unity. Applicant points to claim 8 – not an independent claim- to support a position that the common technical feature of claims 1 and 25 are that there is a combination of a sulfide mineral collector with an oil. Clearly claim 1 does not have such a combined technical feature (as applicant relies on claim 8 for the feature) and this evidence that a holding of lack of unity is proper. Rule 13.1 does not exclude the possibility of a

species lack of unity. Applicant is entitled to present a claim having many different alternative embodiments in a single claim – see claim 1. Such claim may be subjected to a lack of unity review. Applicant intends “natural” and “synthetic” to represent different chemical entities and therefore can be considered in a review of lack of unity.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3,7-18 24, and 32-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear where in the original specification that the claim language regarding “by air-injection” froth flotation is located.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 12-18, 24 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (US 2120217). Harris includes every aspect of claim 1 and 24 save for the air injection (silent) and the amount of natural oil employed in the process. Harris employs 0.4 pounds per ton which is about 180 g/t which might reasonable be interpreted as slightly higher than "less than about 100 g/t" as recited in claims 1 and 24. Harris further recites at pg. 6, col. 2, lines 23-35 that the amount of oil employed in the instant invention of Harris's is "not particularly critical" and that economics demands one employ the least amount possible while still being sufficient to achieve the intended benefit. Clearly, less is better and to so reduce the amount of oil employed would have been obvious to one of ordinary skill in the art.

5. Claims 4-6 and 19-23<sup>and 25-31</sup> are withdrawn as non-elected.  
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Lithgow whose telephone number is 703-308-0173. The examiner can normally be reached on Mon. -Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 703-308-1972. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Thomas M. Lithgow  
Primary Examiner  
Art Unit 1724

TML  
June 2, 2003